

REMARKS

Claims 1-16 are pending in the present application. The Examiner is respectfully requested to reconsider the Restriction Requirement in view of the following Remarks.

The Examiner has required election in the present application between:

Group I, claims 1-6 and 15, drawn to the structures/structural elements of a piezo-film speaker, in class 381, subclass 190; and

Group II, claims 7-14 (and 16), drawn to the structures/structural elements of a motorcycle helmet, in class 2, subclass 410.

For the purpose of examination of the present application, Applicant elects, with traverse, Group II, claims 7-14 and 16. It should be noted that the Examiner has not mentioned claim 16 in the Office Action. Since claim 16 depends on claim 7, this claim should be considered along with the elected invention of claims 7-14.

In order to be responsive to the Examiner's Restriction Requirement, Applicant has elected claims 7-14 and 16 for initial examination. However, Applicants submit that the Examiner's restriction requirement is improper and should therefore be withdrawn.

The Examiner indicates that the above Groups I and II are related as combination and subcombination. In addition, the Examiner states that Groups I and II are distinct since "the combination as claimed does not require the particulars of the subcombination as claimed because the invention I [is] only drawn to a speaker, which has separate utility, such as to be utilized in a hat." Applicant submits that the Examiner's rationale is incorrect for the following reasons.

In order for the Examiner to show distinction between combination claims and subcombination claims, the Examiner must show two (2) way distinction. The Examiner has shown that the subcombination has separate utility, since the speaker of the present invention can be used in a hat. However, the Examiner has not shown that the "combination as claimed does not require the particulars of the subcombination as claimed for patentability." The subcombination claims are recited verbatim in the combination claims. In view of this, there is no aspect of the subcombination that is not recited in the combination claims.

The Examiner states that "Invention I [is] only drawn to a speaker." This is exactly the opposite of what the Examiner must prove to show distinction. The Examiner must show that there is something in Invention or Group I (the subcombination claims) that

is not included in Invention or Group II (the combination claims). Since all of the elements in the subcombination claims are also present in the combination claims, the Examiner has not shown distinction in the present situation. If the Examiner's standard for restriction were used, it would be impossible to ever have combination claims and subcombination claims in the same application.

Specifically, the Examiner has shown that there is something in the combination claims that is not in the subcombination claims, rather than showing something in the subcombination claims that is not in the combination claims. As mentioned above, distinction between combination and subcombination claims is shown by showing that "the combination as claimed does not require the particulars of the subcombination as claimed for patentability," not that the subcombination does not require the particulars of the combination as the Examiner has done.

In other words, the Examiner must show that there is some element in Group I that is not included in Group II. Since all of the particulars of the subcombination claims are recited in the combination claims, distinction cannot be shown.

In addition, it is respectfully requested that the Examiner reconsider the Restriction Requirement since no serious burden

would be presented to the Examiner by examining all of the claims in a single application.

As set forth in § 803 of the MPEP, the Examiner must examine an application on the merits if the examination of the entire application can be made without serious burden. Two criteria are identified for proper requirement for restriction:

1. The inventions must be independent or distinct as claimed; and
2. There must be a serious burden on the Examiner if the restriction is not required.

Applicant respectfully submits that a serious burden has not been placed on the Examiner to consider all of the claims in a single application. The Examiner is respectfully requested to consider all of the claims in the present application and to withdraw the restriction requirement.

In order to be responsive to the Examiner's Restriction Requirement, claims 7-14 have been elected with traverse. If the Examiner does persist in this Restriction Requirement, Applicant reserves the right to file a divisional application directed to the non-elected claims at a later date if it is so desired.

Favorable action on the present application is earnestly solicited.

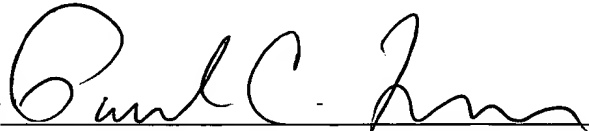
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Paul C. Lewis (Reg. No. 43,368) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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